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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/648,325	08/25/2000	Andrew John Holmes	TS7564 (US)	6381

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Kimbley L Muller
c/o Shell Oil Company
Legal Intellectual Property
P O Box 2463
Houston, TX 77252-2463

EXAMINER

JOHNSON, JERRY D

ART UNIT	PAPER NUMBER
1764	10

DATE MAILED: 11/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

AS/7

Office Action Summary	Application No.	Applicant(s)
	09/648,325	HOLMES ET AL.
	Examiner Jerry D. Johnson	Art Unit 1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 03 September 2002.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 and 4-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1 and 4-6 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Denis et al.

Denis et al teach fully formulated crank case oils containing 1) 0.3 to 2 weight percent VI improvers; 2) 0.5 to 3 weight percent zinc dithiophosphates anti-wear agent; 3) about 1 to 15 weight percent nitrogen-containing and/or polyol dispersants; 4) 0.2 to 3 weight percent of an overbased magnesium salicylate (column 12, lines 4-68; column 13, lines 1-21). While Denis et al do not specifically disclose additives of applicants' formula (I) (i.e., polyol dispersants formed by the reaction of a polyol and a high molecular weight alkylated succan as taught in column 12, lines 24-29) or compositions wherein the ratio of magnesium salicylate to zinc dithiophosphate is within the claimed range, it would have been obvious to one having ordinary skill in the art at the time the invention was made to follow the above teachings and arrive at a composition having the claimed components and component amounts.

Claims 1 and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matthews et al in view of European Patent Application 0 434 464 A1 and Karn.

Matthews et al, U.S. Patent 4,462,918, teach lubricating oil compositions, and in particular a lubricating oil composition which may be used as a hydraulic fluid (column 1, lines 5-7). The composition comprises a major proportion of a lubricating oil and a minor proportion of each of a Group II metal dithiophosphate and a compound of applicants' formula I (column 1,

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lines 30-48). The combination of the Group II metal dithiophosphate anti-wear additive with compounds of formula I gives improved anti-wear performance (column 1, lines 49-60). Most preferably, the Group II metal dithiophosphate is a zinc dialkyl dithiophosphate of which the alkyl groups contain 3-20 carbon atoms (column 2, lines 7-14). The combination of additives may suitably be used with other additives (column 2, lines 38-42). While Matthews et al teach the addition of other additives, Matthews et al differ from the instant claims in not teaching the addition of a magnesium salicylate.

European Patent Application 0 434 464 A1 (hereafter EPA '464) teach lubricant compositions especially useful as hydraulic fluids containing an amino succinate ester as corrosion inhibitor (abstract). EPA '464 teach that when used in an acidic environment, it can be desirable to incorporate, inter alia, overbased alkylsalicylate (page 3, lines 49-52).

Karn, U.S. Patent 4,627,928, is relied on as teaching overbased magnesium alkylsalicylates as additives for hydraulic fluids (column 17, lines 41-47).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to add the overbased magnesium alkylsalicylate of Karn to the lubricating composition of Matthews et al as taught by EPA '464 and because Matthews et al specifically teach that other additives may be incorporated into the composition of their invention.

Claims 1 and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujitsu et al. in view of Matthews et al.

Fujitsu et al, U.S. Patent 6,114,288, teach lubricating oil compositions comprising a zinc dialkyldithiophosphate and a metallic detergent chosen from calcium alkylsalicylate and a mixture of calcium alkylsalicylate and magnesium alkylsalicylate (abstract). In Tables 2 and 3

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of Fujitsu et al., lubricating compositions comprising magnesium salicylate, zinc dialkyldithiophosphate, defoaming agent and pour point depressant are disclosed. In column 5, lines 13-15, Fujitsu et al specifically teach the addition of alkenyl succinic acid or ester moieties thereof as rust preventing additives for their lubricating compositions.

Matthews et al, U.S. Patent 4,462,918, teach lubricating oil compositions comprising a major proportion of a lubricating oil and a minor proportion of each of a Group II metal dithiophosphate and a compound of applicants' formula I (column 1, lines 30-48). The combination of the Group II metal dithiophosphate anti-wear additive with compounds of formula I used as anti-rust agents in lubricating oil compositions gives improved anti-wear performance (column 1, lines 49-60). The combination of additives may suitably be used with other additives (column 2, lines 38-42).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to a compound of formula I as taught by Matthews et al to the lubricating composition of Fujitsu et al because Fujitsu et al specifically teach the addition of such compounds. Additionally, one having ordinary skill in the art would have been motivated by the desire to increase the anti-wear performance of the lubricating composition as taught by Matthews et al.

Applicant's arguments filed September 3, 2002 have been fully considered but they are not persuasive.

Applicants argue

[t]here is no teaching or suggestion in the combined references to arrive at the claimed composition. The '918 reference does not teach the magnesium salicylate. The '464 reference mentions the addition of an alkaline earth metal alkylsalicylate, but indicates a preference for the calcium compound. The '928 reference is directed toward anti-

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oxidants rather than agents for purposes of thermal stability and anti-wear purposes. Therefore, this combination of references does not teach or suggest the elements of the claims. (Remarks, page 4).

Applicants' argument lacks merit.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicants argue

[t]he '288 reference is directed toward the improvement of wear resistance in moving value parts in an internal combustion engine. The instant application is directed toward the improvement of thermal stability and wear under low load in a hydraulic fluid. The person skilled in the art at the time of the instant invention would not have looked to the '288 reference for guidance with respect to hydraulic fluids. Similarly, although the '918 reference is directed toward hydraulic fluids, it is not directed towards solving problems with thermal stability at low loads. Therefore, there is no motivation to combine these two references to arrive at the instant invention. (Remarks, page 4).

Applicants arguments lack merit.

As long as some motivation or suggestion to combine the references is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor. *In re Kronig*, 539 F.2d 1300, 1304, 190 USPQ 425, 427-428 (CCPA 1976); *In re Lintner*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

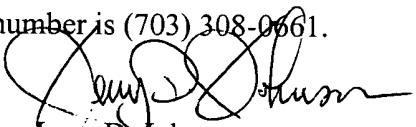
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry D. Johnson whose telephone number is (703) 308-2515. The examiner can normally be reached on 6:00-3:30, M-F, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marian Knodel can be reached on (703) 308-4311. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-5408 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Jerry D. Johnson
Primary Examiner
Art Unit 1764

JDJ
November 13, 2002